

Arguments/Remarks

Claims 1 to 58 are currently pending.

Claims 59 and 60 have been cancelled. Claims 1, 11, 34, 35, 42, 43, 44, and 58 are amended. Claims 61 and 62 were submitted in the Amendment and Response filed February 26, 2010; these claims were not entered, as noted in the Advisory Action of March 16, 2010; these claims are not re-submitted herein and thus are not pending.

Amendments to claims 1, 11, 34, 35, and 42 correct minor punctuation, grammatical and spelling errors. The amendments to claims 43 and 44 are discussed below. Support for the claim amendments to claims 43 and 44 can be found throughout the Specification, e.g., at page 1, first and second paragraphs of the Background to the Invention; page 2, third and fifth paragraphs; and page 5, last paragraph. The amendment to claim 58 is intended to correct an obvious error; support for this amendment can be found in the Specification, at page 52, last paragraph, and in this claim as previously filed. No new matter is added.

With respect to any claim amendment or cancellations (including claims 59-62), Applicants have not dedicated to the public or abandoned any unclaimed subject matter, and moreover have not acquiesced to any rejections and/or objections made by the Office. Applicants expressly reserve the right to pursue prosecution of any presently excluded subject matter or claim embodiment in one or more future continuation and/or divisional application(s).

Applicants thank the Office for acknowledging and entering the amendment filed 8/3/2009, and for withdrawing the rejections that are not reiterated in the current Office Action and Advisory Action.

Advisory Action

This Amendment and Response is in response to the Office Action dated December 7, 2009, and the Advisory Action dated March 16, 2010.

The Advisory Action noted that, to avoid abandonment of this application, applicant must timely file one of several responses, including: an amendment, affidavit, or other evidence, which places the application in condition for allowance. Applicants respectfully submit that the present Amendment resolves all outstanding issues and places this application in condition for immediate allowance.

In the Advisory Action, it was noted that the Amendments filed on February 26, 2010, were not entered.

In the Advisory Action, it was also noted that the terminal disclaimer filed by Applicants was not accepted, as the person signing the terminal disclaimer was not of record. This deficiency is corrected by new documents filed herewith.

The Advisory Action further noted that the proposed amendments raised new issues that would require further consideration and/or search. The Amendment submitted new claims 61 and 62, but the Advisory Action noted that these new claims would introduce new issues and new considerations. Without acquiescing on the validity of this argument, and without dedicating to the public or abandoning the claimed subject matter, and while noting that these are dependent claims which fall within the scope of their respective base claims, Applicants have not re-submitted claims 61 and 62 herein, and thus these claims are not pending. Thus, this issue is obviated.

Finally, the Advisory Action noted that the pending claims remained rejected for reasons of record. These rejections are addressed below, and arguments are reiterated from the Amendment filed February 26, 2010.

Applicants respectfully submit that the present submission and associated documentation obviates all the outstanding issues and places the application in condition for immediate allowance.

Telephonic Interviews

The Applicants' Representative Frank Wu thanks Examiner Jon E. Angell for his time on February 23, 2010, for a telephonic interview related to this case.

In that interview, claim amendments to claims 43 and 44 were discussed. Agreement with respect to these claims was reached. The current amended claim set reflects the amendments discussed in the interview.

Rejections to claims 59 and 60 were also discussed. Agreement with respect to these claims was not reached. These claims are herein cancelled.

The Double Patenting rejection was also briefly discussed, and agreement was reached.

In addition, no exhibits were shown or demonstrations conducted during the telephonic interview. Aside from the U.S. Patent No. 6,670,468, no prior art was discussed.

The current Amendment reflects the substance of the telephonic interview.

The Applicants' Representative Frank Wu also thanks Examiner Jon E. Angell for his time on May 5, 2010, for another telephonic interview related to this case, to discuss the Advisory Action dated March 16, 2010.

In that interview, the Double Patenting rejection was discussed, and agreement was reached.

The deletion of claims 61 and 62 was also discussed, and agreement was also reached.

The claim amendments to claims 43 and 44, which were presented in the Amendment filed February 26, 2010, but not entered, were also discussed, and agreement was reached.

No exhibits were shown or demonstrations conducted during the telephonic interview. No prior art was discussed.

The current Amendment reflects the substance of the telephonic interview.

Double Patenting

In the Office Action of December 7, 2009, the Office had rejected claims 1 to 60 on the ground of nonstatutory obviousness-type double patenting, as allegedly being unpatentable over claims 1 to 4 of U.S. Patent No. 6,670,468. The Office has also noted that a timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground.

In the Amendment of February 26, 2010, a terminal disclaimer was filed.

The submitted terminal disclaimer was not accepted, as noted in the Advisory Action of March 16, 2010. According to the Terminal Disclaimer Informal Checklist dated March 9, 2010, "The person who signed the terminal disclaimer ... does not have power of attorney, and thus, is not of record."

Filed herewith are the following documents: (1) a copy of the Assignment signed by the inventors to Novartis AG; (2) a statement under 37 C.F.R. 3.73(b) signed by Mr. Wu; (3) a new Power of Attorney (POA) signed by Attorney of Record Paul Paglierani, which appoints Practitioners associated with the Customer Number 75074 (Novartis AG), including Mr. Wu; and (4) a new terminal disclaimer signed by Mr. Wu reciting Novartis AG as the assignee.

Applicants respectfully request acceptance of the attached terminal disclaimer and withdrawal of this rejection.

Claim Rejections – 35 U.S.C. §112, second paragraph

Claims 43 and 44 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

Claim 43 was an independent method claim providing an antisense oligonucleotide. The Office had alleged that language in the claim did not constitute a clear and actual method step. While Applicants traverse the rejection, this claim has been re-written as a dependent claim, depending from the method claim 42.

Claim 44 was a method claim depending from claim 43 and citing the oligonucleotide derivative of claim 12. The Office had alleged that the claim was incomprehensible and indefinite. While Applicants traverse this rejection, claim 44 has been re-written as a claim

claiming the oligonucleotide derivative of claim 12, wherein the oligonucleotide derivative comprises an antisense oligonucleotide.

Applicants respectfully submit that these claim amendments obviate this rejection.

Withdrawal of this rejection is respectfully requested.

Claims Rejections – 35 USC §112/101

The Office has rejected Claims 59 and 60 under 35 USC §112/101.

The Office has stated that these claims do not set forth any steps involved in the method/process.

Applicants respectfully traverse. Claim 59 recites steps related to forming a hybrid between the oligonucleotide and a target RNA, and inhibiting the ribosomal translation process of the target RNA. Claim 60 recites steps related to forming a triple helix between the oligonucleotide derivative and a double-stranded gene segment or DNA segment, and inhibition transcription.

Nonetheless, in an effort to advance prosecution of this application and without acquiescing to the validity of this rejection, Applicants have cancelled claims 59 and 60, rendering this rejection moot.

Withdrawal of this rejection is thus respectfully requested.

Conclusions

Reconsideration and withdrawal of the rejections in view of the amended claims is hereby requested. In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Office is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Office is invited to telephone the undersigned at the number given below. In the event that the Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to the Deposit Account noted above. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,



Frank Wu
Agent for Applicants

Novartis Institutes for Biomedical Research, Inc.
220 Massachusetts Ave 602-230H
Cambridge, MA 02139

(617) 871-5077

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